

REMARKS

Claim 1 has been amended in a manner corresponding to claim amendments made in Applicant's commonly-owned corresponding International Patent Application Serial Number PCT/US00/25862. Included herewith is an Information Disclosure Statement citing and including copies of an International Search Report, Written Opinion, and International Preliminary Examination Report issued by the European Patent Office in the above-identified International Patent Application, for the Examiner's consideration. The amendment to claim 1 recites subject matter illustrated in, for example, Figs. 2d-2e, and disclosed in the specification on, for example, pages 5-8, 10-16, and 26-27. No new matter has been added.

Claims 28-46 were previously withdrawn from consideration by the Patent Office. As a result, claims 1-27 and 47-57 are currently pending and under consideration with claims 1, 13, 26, 47, 48, 49, and 53 being independent claims.

Rejections Under 35 U.S.C. § 103(a)

I. Rejection of claims 1, 2, 7-15, 20-25, 49, and 52 as being unpatentable over U.S. Patent No. 6,247,215 to Van Alboom et al. (hereinafter Van Alboom).

The Office Action states that Van Alboom teaches that it is known to texture a flocked fabric by air embossing and thereafter printing the fabric. The Office Action states that the processed described by Van Alboom would inherently impart to a fabric "visually discernable regions," "3-D texture," and "depressions." The Patent Office concedes in the Office Action that Van Alboom does not disclose superimposition of an embossed pattern and printed pattern in the manner recited in Applicant's rejected claims, but argues that such limitations are merely reflective of an aesthetic "design choice" and are relevant to ornamentation only and thus have no functionality that can be relied upon to patentably distinguish Applicant's claimed invention from Van Alboom. The Patent Office suggests that case law supports the contention that absent evidence that Applicant's particular claimed configurations are "significant," such configurations cannot support the patentability of the claimed invention over Van Alboom.

As an initial matter, Applicant notes that the present basis for rejection cannot be maintained because Van Alboom is not prior art against Applicant's application for the purposes of establishing a rejection under 35 U.S.C. § 103(a).

Applicant notes that Van Alboom has an issue date (June 19, 2001), which is after the filing date (September 21, 2000) of the present application, so that Van Alboom is not prior art under either 35 U.S.C. §102(a) or §102(b). It appears that the Patent Office is applying Van Alboom as prior art under 35 U.S.C. §102(e) based upon its earlier effective filing date. However:

STATEMENT OF COMMON OWNERSHIP

**THE PRESENTLY CLAIMED INVENTION AND U.S. PATENT NO. 6,247,215
TO VAN ALBOOM ET AL. WERE, AT THE TIME THE PRESENTLY
CLAIMED INVENTION WAS MADE, OWNED BY OR SUBJECT TO AN
OBLIGATION OF ASSIGNMENT TO MICROFIBRES, INC.**

Accordingly, because the present application was filed after November 29, 1999, Van Alboom, which is prior art only under 35 U.S.C. §102(e) is disqualified as prior art against the present application pursuant to 35 U.S. C. §103(c). For this reason alone Van Alboom cannot support the present rejection, and reconsideration and withdrawal of the rejection is respectfully requested.

Moreover, regarding the merits of the rejection, the Applicant disagrees that the limitations regarding the particular orientation and relevant positioning of the printed and embossed patterns are merely matters of routine "design choice" relating to ornamentation and not to function. Contrary to this assertion made by the Patent Office, the relative shaping, positioning, and configuration of the visually discernable embossed regions and the visible features of the printed pattern, for example as recited in claim 1, do not constitute a mere matter of ornamentation or routine design choice.

To the contrary as described in detail in Applicant's specification on, for example, page 7, line 32- page 8, line 10; and page 13, lines 11-23, the relationships between the embossed regions and the printed features on the pile fabric, for example as recited in Applicant's claim 1,

have been discovered and determined by the present inventor to advantageously enable the embossed regions to create a texture imparting a more realistic visual effect to the printed features, often this effect can be dramatic and can significantly improve the functionality and performance of the fabric.

The claimed configurations of embossed and printed features are not merely a matter of ornamentation but, rather comprise a significant and important structural feature of the claimed fabrics, that can substantially improve their functionality. For example, as described on page 7, lines 6-30, such inventive texturing/printing superimposition can serve to reduce the visual contrast of the fabric with its surroundings, thereby enabling it to better blend in with its surroundings such that it has substantially improved functionality as, for example, a camouflage fabric. Such features do not, therefore, merely reflect "ornamentation" and provision of "specific design patterns" that are mere matters of "design choice," as maintained in the Office Action.

Accordingly, even if the cited Van Alboom were applicable as prior art in the context of the current rejection, which it is not as explained above, the reference still does not support a *prima facie* case of unpatentability of the rejected claims under 35 U.S.C. § 103(a).

II. Rejection of Claims 1, 2, 7-15, 20-25, 49, and 52 as being unpatentable over International Application Publication No. WO 00/71802 to Microfibres, Inc., naming Laird et al. as inventors (hereinafter Laird)

Providing a substantially similar rationale as set forth in the above-discussed rejection under §103(a) of these claims over Van Alboom, the Office Action states that the presently rejected claims are also obvious in view of Laird.

While the Applicant does not concede the merits of the rationale set forth in the Office Action in support of the present rejection, Applicant points out that the present rejection is improper and cannot be maintained because the Laird reference does not appear to be prior art to the present application.

Specifically, Applicant notes that the International Publication Date of Laird (November 30, 2000) is subsequent to the filing date of the present application (September 21, 2000), so that Laird is not applicable as prior art under either §102 (a) or §102 (b).

Nor is Laird prior art under §102(e) either. Applicant notes that the international filing date of Laird is May 22, 2000. As pointed out in the MPEP §706.02(f)(1) - "Examination

Guidelines for Applying References Under 35 U.S.C. 102 (e)" – international application publications resulting from international applications filed prior to November 29, 2000 do not have any 35 U.S.C. §102(e) prior art date (see Example 6 (page 700-33), and Flow Chart II (page 700-38) provided in the above-identified section of the MPEP). For this reason, it is believed that the present rejection cannot be maintained and reconsideration and withdrawal of the rejection on the present basis is respectfully requested.

III. Rejection of Claims 3-6, 16-19, 26-27, 47, 48, 50, 51, and 53-57 as being unpatentable over the cited Laird reference as applied above further in view of U.S. Patent No. 5,756, 180 to Squires et al. (hereinafter Squires)

The basis for the present rejection appears to be that Laird (and Van Alboom) teach all of the limitations of the presently rejected claims except do not teach a camouflage flocked fabric. The Office Action states that Squires discloses a flocked camouflage pattern and it would have been obvious to one of ordinary skill in the art to combine Laird or Van Alboom with Squires to arrive at the invention as claimed. The Office Action states that the motivation to do so would be to provide an "aesthetically pleasing and marketable product."

Applicant does not agree with the Patent Office that one of ordinary skill in the art would have been motivated to combine the teachings of Laird or Van Alboom with Squires along the lines suggested in the Office Action, for essentially the reasons previously stated by the Applicant and his Amendment A. Moreover, for at least the reasons set forth above in Applicant's response to the rejections under §103(a) in view of Van Alboom and Laird, the foundation of the present rejection (i.e. that Laird or Van Alboom can properly be applied as prior art in the context of the present rejection and teach or render obvious all of the limitations of the presently rejected claims, with the exception of camouflage) is believed to be incorrect. Thus, the present rejection cannot stand and withdraw of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.


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Conf. No.: 9117

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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